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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,845	12/24/2001	William H. Reeves	L-00003-004	4172

25179 7590 09/08/2004
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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,845

Applicant(s)

REEVES ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/04 has been entered.

Claim Objections

2. Claim 1 is objected to because of the following informalities: Line 3 states, "having an connectable...". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 5 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,758,806 to Kamrava et al.

In regards to claims 1, 4, 5 and 12, Kamrava et al. discloses an introducer needle (112) which is tubular having a connectable open end and a second terminal open end (Col. 5, lines 63 – 64) and a diameter to co-receive an optic fiber (157) and a tissue removing member (Col. 5, lines 27 – 48); a microendoscope (111) having a housing with an open surface end sealably connected to the

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connectable end (Col. 4, lines 15 – 16), an optic fiber (157) operably extending through the open surface end and which is inserted into the needle (112) in a manner to enable an image to be obtained (Col. 5, lines 45 – 47), the housing having a first channel to receive the optic fiber (157), a second channel to receive an optic light source (Col. 4, lines 58 – 62), and a third channel (Col. 4, line 52), each channel is separate and continuous; and a tissue removing member (Col. 6, lines 23 – 41) insertable through the third channel. The ends of the needle and optic fiber are generally co-terminus (Col. 5, lines 60 – 64). Kamrava et al. discloses the optic fiber being illuminated and a camera connected to the first channel for viewing the image seen through the optic fiber (Col. 4, lines 4 – 5). A flexible tubing (136) covers the optic fiber.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable U.S. Patent No. 6,758,806 to Kamrava et al. in view of U.S. Patent No. 5,873,814 to Adair.

In reference to claims 6 – 8, Kamrava et al. discloses a camera being connected to a monitor (Col. 4, lines 4 - 5). However, Kamrava et al. fails to disclose the monitor being connected to a computer having software to enable viewing of the image, a touch screen monitor, and the computer including a microphone and having voice recognition software associated with the microphone to permit notes to be recorded. Adair teaches an endoscopic video touch screen monitor (Col. 4, lines 36 – 42; lines 49 – 65) and a computer having a microphone and voice

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recognition software associated with the microphone to permit notes to be recorded (Col. 4, lines 58 – 65; Col. 8, lines 60 – 62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the monitor as disclosed by Kamrava et al. to be a touch screen monitor connected to a computer including a microphone and voice recognition software as taught by Adair to assist a user in manipulating the image or in recording data represented by the image without any physical contact by the user with the monitor (Col. 4, lines 49 – 60).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,758,806 to Kamrava et al. in view of U.S. Patent No. 5,722,423 to Lind et al.

In regards to claim 10, Kamrava et al. discloses the microendoscope being located in a patients uterus (Col. 2, lines 44) and having an operational channel (120) through which instruments may be inserted. Lind et al. discloses a cytology brush for being inserted into the operational channel of an endoscope (Col. 6, lines 59 – 61). It would have been obvious to one having ordinary skill in the art to use the cytology brush as taught by Lind et al. with the microendoscope as disclosed by Kamrava et al. in order to obtain a microbiological biopsy specimen from the patient (Col. 6, lines 25 – 26).

Claims 2, 3, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,758,806 to Kamrava et al. in view of U.S. Patent Application Publication No. 2003/0083552 to Remijan et al.

In regards to claims 2, 3, 9 and 11, Kamrava et al. discloses the housing including a port (Col. 6, lines 45 – 46) communicating with the third channel and having an open connector surface sealably connectable to the needle (Col. 4, lines 14 – 17). Kamrava et al. discloses the housing having a generally v-shape (Figure 4). Additionally, Kamrava et al. discloses an introducer needle (112). However, Kamrava et al. fails to disclose the needle being equipped with a stylet which extends

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through the needle to block unwanted material from entering the needle and including an end which seats against the neck of the needle and which can be gripped to permit removal. Remijan et al. discloses a microendoscope having an introducer needle with a removable stylet that seats against the neck of the needle that can be gripped [0043] – [0045]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the needle as disclosed by Kamrava et al. to include a stylet as taught by Remijan et al. in order to position the microendoscope within the body to view the desired location [0043].

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,846,221 to Snoke et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703) 305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703)308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JMLF



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